

REMARKS

Claims 1 through 17 are pending in this application. In response to the Office Action dated June 16, 2003, claims 3, 10, 11, 12, 13, 14 and 17 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicants submit that the present Amendment does not generate any new matter issue.

The Examiner objected to the title of the invention. Applicants have amended the title and submit that the title, as amended, is clearly indicative of the invention as claimed. Withdrawal of the objection is respectfully solicited.

The inadvertent spelling discrepancy noted by the Examiner, at page 5, line 25 of the specification, has been corrected. Accordingly, the Examiner is requested to reconsider and withdraw the objection.

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The Examiner objected to the drawings under 37 CFR § 1.83(a). The Examiner stated that the ribbon or stack twisted lengthwise in one direction is not shown in the drawings. Applicants respectfully traverse. Applicants submit that Fig. 5b of the present invention depicts this claim limitation and, further, it is described in the specification at page 8, lines 5-20. Accordingly, the Examiner is requested to reconsider and withdraw the objection.

The Examiner stated that Figures 2, 5A, 5B and 7 should be designated by a legend such as "Prior Art" since these figures are discussed in the section entitled Description of Related Art. Figures 5A and 7 have been amended and designated as "Prior Art". However,

Figs. 2 and 5B are illustrated embodiments of the present invention. The Examiner's attention is invited to page 3, lines 4-13 of the specification, wherein Fig. 2 of the **JP 4-182608** reference is discussed and **not** Fig. 2 of the present invention. Moreover, Fig. 5A, contrary to the Examiner's assertion, is not discussed in Description of Related Art section of the present specification. Accordingly, the Examiner is requested to reconsider and withdraw the objection.

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The Examiner objected to the drawings under 37 CFR 1.83(a) as allegedly failing to disclose the "pitch length of the grooved spacer being twice as large as the predetermined pitch length" as described in the specification on page 5. Applicants respectfully traverse. Applicants submit that pitch length of the grooved spacer being twice as large as the predetermined pitch length can be extrapolated from Fig. 7. The predetermined pitch length indicates a length from S1 to S2, as shown in Fig. 7. See also the description at page 2. Thus, one of ordinary skill in the art would have no difficulty understanding this illustrated structural detail. Accordingly, the Examiner is requested to reconsider and withdraw the objection.

Claims 3, 12, 13, and 14 were objected to for grammatical informalities. Applicants have amended these claims to address the Examiner's concerns. Thus, withdrawal of the objection of claims 3, 12, 13 and 14 is respectfully solicited.

Claims 3, 5-9 and 15-17 were rejected under 35 U.S.C. § 112, second paragraph. The Examiner asserted that it was unclear how the spacer of claim 3 can be simultaneously linear lengthwise and twisted spirally. Applicants respectfully traverse.

Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a question of law. *Tillotson Ltd. v Walbor Corp.*, 4 USPQ 2d 1450 (Fed. Cir. 1987). Accordingly, in rejecting a

claim under the second paragraph of 35 U.S.C. § 112, the PTO is required to discharge its initial burden for providing a basis in fact and/or cogent reasoning to support the ultimate legal conclusion that one having ordinary skill in art, with the supporting specification in hand, would not be able to reasonably ascertain the scope or protection defined by the claim.

In re Cartwright, 49 USPQ 2d 1464. Consistent judicial precedent holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Miles Laboratories, Inc. v. Shandon, Inc.*, 27 USPQ 2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc. v. Amercian Cyanamide Co.*, 28 USPQ 2d 1333 (Fed. Cir. 1993); *U.S. v. Telectronics, Inc.*, 8 USPQ 2d 1217 (Fed. Cir. 1988).

Applicant stresses that a patent specification must be viewed through the eyes of one having ordinary skill in the art. *Miles Laboratories, Inc. v. Shandon, Inc.*, *supra*.

In applying the above legal tenets to the exigencies of this case, Applicants submit that one having ordinary skill in the art would not have been confused by the use of the above description particularly as employed in the context of the claimed invention. Applicants submit that the spacer is twisted around the central member spirally (as recited in claim 2, and depicted in Figs 1-2) and that the one groove (recited in claim 3, and depicted in Fig. 5B) is linear lengthwise. Thus, the terminology is consistent and clear in view of the supporting disclosure. Accordingly, one having ordinary skill in the art would not have difficulty understanding the scope of the presently claimed invention, particularly when reasonably interpreted in light of the supporting specification. The Examiner provided no arguments to justify why one having ordinary skill in the art would have had difficulty understanding Applicant's claimed invention. Therefore, it is respectfully submitted that the

imposed rejection under 35 U.S.C § 112, second paragraph is not legally viable and hence, solicit withdrawal thereof.

With respect to claim 17, the Examiner asserted that there is insufficient antecedent basis for the limitation one-groove spacers at lines 4-5. Claim 17 has been amended to provide antecedent basis. Descriptive support for the proposed claim amendment is found at page 9, lines 16-23. Accordingly, the Examiner is requested to reconsider and withdraw the rejection.

Claims 1, 4 and 10-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Wagman et al. (U.S. Pat. No. 5,517,591, hereinafter "Wagman"). Further, claims 2 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wagman in view of Eoll (U.S. Pat. No. 5,651,082). The Examiner referred to Figures 1-2 and 4 and the accompanying specification of Wagman, asserting the disclosure of an optical cable corresponding to that defined in claims 1, 4 and 10-11. Applicants respectfully traverse the rejections for the reasons stated below.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*,

730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the device disclosed by Wagman that would preclude the factual determination that Wagman identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Independent claim 1 describes an optical cable having at least one groove which is spirally provided. Each groove being substantially square in cross section and holding an optical fiber ribbon or a stack of a plurality of optical fiber ribbons within the groove. An inner width and a height of side walls of each groove are set greater than a width of the optical fiber ribbon or a diagonal length of the stack which is held into the groove. The optical fiber ribbon or said stack held into said groove is twisted lengthwise in one direction.

Applicants submit that Wagman does not disclose an optical cable comprising, *inter alia*, an optical fiber ribbon or stack that is twisted lengthwise in one direction, as required by claim 1. In fact Wagman teaches away from the present invention by intentionally reducing the rotation of the fiber ribbon in the slot/groove. See col. 2, lines 35-44, col. 3, lines 10-13 and Fig 4. Thus, Wagman does not identically disclose each feature of the claimed invention and the rejection should be withdrawn. *In re Rijckaert, supra*.

Moreover, Eoll does not remedy the deficiencies of Wagman. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

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Eoll similarly teaches, at col. 4, lines 50-59, that the innermost major surface of ribbon 9 is adjacent to the slot floor 49, as depicted in Figs. 2-3. Thus, neither reference teaches an optical cable comprising an optical fiber ribbon or stack that is twisted lengthwise in one direction, as required by independent claim 1. Accordingly, the rejection under 35 U.S.C. 103(a) is not legally viable and should be withdrawn.

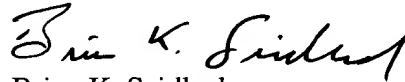
Applicants note with appreciation that the Examiner indicated that claims 13 and 14 would be allowable if recast in independent form. Further the Examiner indicated that claims 3, 5-9 and 15-17 would be allowable if amended to overcome the rejections under 35 U.S.C. § 112 and rewritten in independent form. However, it is believed that these various dependent claims are allowable with the independent claim, hence, rewriting claims in independent form should not be necessary at this time.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Brian K. Seidleck
Registration No. 51,321

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 BKS:amz
Facsimile: (202) 756-8087
Date: September 11, 2003